



**GOVERNMENT OF PUERTO RICO**  
DEPARTMENT OF STATE



November 17, 2022

Kevin A Preisach Perez  
92 Calle Maguey  
Canóvanas, PR 00729-9829

**SUBJECT MATTER**  
**MARK**

**Office Action**



**CLASS**  
**FILING NUMBER**  
**FILING DATE**  
**APPLICANT**

**039**  
**248057-39-0**  
**May 11<sup>th</sup>, 2022**  
**Kevin A Preisach Perez**

To whom it may concern:

In order to proceed with the examination of the said mark Applicant must submit the following information:

- ☐ 1. Clearly state the goods and/or services in connection with the mark as used or intended to be used in commerce in Puerto Rico. This applies if the Applicant customized the selection of goods or services.
- ☐ 2. Provide a drawing of the mark as used or as intended to be used in commerce in Puerto Rico.
- ☒ 3. Provide a detailed description of the mark as used or as intended to be used in commerce in Puerto Rico.

The description must be clarified, and applicant must provide a more detailed description of the applied-for mark. Applications for marks not in standard characters must include an accurate and concise description of the entire mark that identifies literal elements as well as any design elements. The following color claim and mark description are suggested, if accurate:

- **Mark description:** “The mark consists of black background with a gold circle containing a gold bamboo tree with three gold leaves, two on the left side and one on the right. Below the circle lies the wording “HIDDEN EXCURSIONS PR” in gold and, below this, the phrase “A WHOLE NEW LIFESTYLE AT THE PALM OF YOUR HANDS” in gold, between two gold lines.”

- **Color claim: “The colors black and gold are claimed as a feature of the mark.”**

- ☐ 4. Provide a specimen that shows the mark in connection with the goods or services identified in your application.
- ☒ 5. Applicant must disclaim those terms or components of the mark which are not susceptible of exclusive appropriation.

Applicant must disclaim the wording “EXCURSIONS PR” in the mark because it merely describes an ingredient, quality, characteristic, function, feature, purpose, or use of applicant’s goods and/or services, and thus is an unregistrable component of the mark. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004). In this case, applicant must disclaim the wording “EXCURSIONS PR” because it is not inherently distinctive. These unregistrable term(s) at best are merely descriptive of an ingredient, quality, characteristic, function, feature, purpose, or use of applicant’s goods and/or services.

An applicant may not claim exclusive rights to terms that others may need to use to describe their goods and/or services in the marketplace. See *Dena Corp. v. Belvedere Int’l, Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991); *In re Aug. Storck KG*, 218 USPQ 823, 825 (TTAB 1983). A disclaimer of unregistrable matter does not affect the appearance of the mark; that is, a disclaimer does not physically remove the disclaimed matter from the mark. See *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 978, 144 USPQ 433, 433 (C.C.P.A. 1965).

The PRTTO can require an applicant to disclaim an unregistrable part of a mark consisting of particular wording, symbols, numbers, design elements or combinations thereof. The PRTTO can refuse registration of an entire mark if the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods. Thus, the PRTTO may require an applicant to disclaim a portion of a mark that, when used in connection with the goods or services, is merely descriptive, deceptively misdescriptive, primarily geographically descriptive, or otherwise unregistrable (e.g., generic). Failure to comply with a disclaimer requirement can result in a refusal to register the entire mark. Consequently, the following disclaimer must be added:

- **“No claim is made to the exclusive right to use “EXCURSIONS PR” apart from the mark as shown.”**

- ☐ 6. The registration for the applied mark is refused on the following grounds:
- ☐ 7. Other.

According to Rule 27 of Puerto Rico’s Trademark Rules of Procedure, if the PRTTO does not receive a response to the abovementioned remarks within ninety (90) days, the Application shall be considered abandoned.

***Note: Please refer to the name of the Examining Attorney. The office action response shall be filed online at <https://prtmfiling.f1hst.com/>. Please select “RESPUESTA A NOTIFICACION” from the dropdown menu. The cost of said filing is \$15.00. If any questions should arise, you can contact the Examining Attorney at [jtorres@estado.pr.gov](mailto:jtorres@estado.pr.gov) or [marcas@estado.gobierno.pr](mailto:marcas@estado.gobierno.pr)***

Cordially,

A handwritten signature in blue ink, appearing to read "José M. Torres". The signature is fluid and cursive, with the first name "José" and last name "Torres" clearly distinguishable.

José M. Torres, Esq.  
Examining Attorney  
*Puerto Rico Trademark Office*